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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,535	01/28/2002	Marion Hackenthal	10660-59US (10933P4)	3705

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AKIN GUMP STRAUSS HAUER & FELD L.L.P.  
ONE COMMERCE SQUARE  
2005 MARKET STREET, SUITE 2200  
PHILADELPHIA, PA 19103-7013

EXAMINER

MRUK, BRIAN P

ART UNIT	PAPER NUMBER
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1751

9

DATE MAILED: 04/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/058,535

**Applicant(s)**

HACKENTHAL ET AL.

**Examiner**

Brian P Mruk

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. This Office action is in response to Applicant's amendment filed February 7, 2003. New claims 12-19 have been added. Currently, claims 1-19 remain pending in the application.
2. The text of those sections of Title 35 U.S. Code not included in this action can be found in the prior Office action, Paper No. 7.
3. The objection of the Oath for containing foreign priority application number 19935083.3, rather than foreign priority application number 19935083.5, is withdrawn in view of applicant's remarks.
4. The objection of the specification for containing the trademark Optigel<sup>TM</sup> WX on page 5, line 7 is maintained for the reasons of record.
5. The rejection of claims 1-11 under 35 U.S.C. 112, second paragraph, is maintained for the reasons of record.
6. The rejection of claims 1-11 under 35 U.S.C. 102(b) as being anticipated by Massaux et al, U.S. Patent No. 5,849,105, is maintained for the reasons of record.

## **NEW GROUNDS OF REJECTION**

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The phrase "at least about 20%" in claim 15 renders the claim vague and indefinite. The phrase "at least about" renders the claim indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrase "at least about". It is unclear what values are encompassed by the phrase "at least about". The examiner suggests that this phrase should be changed to either "at least" or "about". "Claims reciting "at least about" are invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term about." See MPEP 2173.05(b). Appropriate correction and/or clarification is required.

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10. Claims 12-19 are rejected under 35 U.S.C. 112, second paragraph, for being dependent upon a claim with the above addressed 112 problem in Paper No. 7, Paragraph Nos. 5-11.

### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Massaux et al, U.S. Patent No. 5,849,105.

Instant claims 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Massaux et al, U.S. Patent No. 5,849,105, for the reasons of record found in the last Office action, Paper No. 7, Paragraph No. 13.

### ***Response to Arguments***

13. Applicant's arguments filed February 7, 2003 have been fully considered but they are not persuasive.

Applicant argues that the trademark "Optigel" is indeed capitalized in the specification, in accordance with MPEP 608.01(v). However, the examiner respectfully points out to applicant that MPEP 608.01(v) requires that "Trademarks should be

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identified by capitalizing **each letter of the mark.**" Therefore, the trademark "Optigel" should appear as "OPTIGEL" to comply with MPEP 608.01(v).

Applicant argues that the phrases "pH value of less than about 6" in claim 1, "at least about 20%" in claim 2, and "not more than about" in claims 4 and 5 are definite, since the term "about" is sufficiently definite as to be interpretable by one of ordinary skill in the art. The examiner agrees with applicant on this point, but respectfully points out to applicant that the instant claims recite "**less than about**", "**at least about**", and "**not more than about**" (i.e. phrases which contain both the term "about", in addition to a phrase reciting either "at least", "less than", or "not more than"), which all 3 phrases the examiner held as vague and indefinite according to **MPEP 2173.05(b)**. Again, the examiner relies upon **MPEP 2173.05(b)**, which clearly states "Claims reciting "less than about" are invalid for indefiniteness where there was close prior art and there was nothing in the specification, prosecution history, or the prior art to provide any indication as to what range of specific activity is covered by the term about." The examiner maintains that all 3 of these phrases render the claims indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrases. Furthermore, does a composition that has a pH of 6.2 meet the limitation "less than about 6" in instant claim 1? Since applicant has not provided any indication as to what specific activity is covered by the term "about", the examiner maintains the rejection. The examiner suggests that the phrases should be amended to recite "less than", "at least", and "not more than" to be considered definite.

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Applicant argues that the phrase “the abrasive agent comprises substantially entirely organic material” in claim 3 is held to be definite. However, the examiner maintains that the phrase “the abrasive agent comprises substantially entirely organic material” in claim 3 renders the claim vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrase “substantially entirely”. Again the examiner asks “Does a composition which contains 85% of an organic abrasive and 15% by weight of an inorganic abrasive meet the “substantially entirely organic material” limitation?” Furthermore, neither the specification nor applicant’s prosecution history provides guidelines describing what numerical values are encompassed by the phrase “substantially entirely”, and thus, the examiner maintains the rejection.

Applicant argues that the phrase “the organic material is predominantly present” in claims 8 and 9 would be understood by one having ordinary skill in the art at the time of the invention to include particles that are a little bit smaller and a little bit greater than the listed size ranges. However, the examiner asserts that the phrase “predominately present” renders the claims vague and indefinite, since one of ordinary skill in the art would not be able to ascertain the metes and bounds of the phrase “predominantly present”. Again, the examiner asks “Does a composition which contains 80% of the organic material particles within a range of 10-1000 micrometers (claim 8) or a range of 100-200 micrometers (claim 9) meet the “predominantly present as particles in a size range...” limitation? Furthermore, the examiner asserts that the term “about” in instant claims 8 and 9 cover the ranges of the particles that are a little bit smaller and a little bit

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greater than the listed size ranges. The examiner suggests that the phrase "the organic material is predominantly present as particles in a size range of about" should be amended to recite "the organic material is present as particles in a size range of about" to be considered definite.

Applicant argues that Massaux et al, U.S. Patent No. 5,849,105 (hereinafter "Massaux"), does not teach or suggest that the cleaner would be appropriate for glass ceramic surfaces claimed in the instant invention. However, the examiner asserts that Massaux discloses that the liquid crystal composition is used to clean hard surfaces, such as vitreous, wash bowls, bathtubs and tiling by applying the composition to the hard surface (see col. 2, lines 36-40; col. 4, lines 15-20; and col. 10, lines 15-25), which encompass the glass ceramic surface of the instant invention. Furthermore, even if the surfaces disclosed by Massaux are different than the glass ceramic surface of the instant invention (which the examiner is not admitting), the examiner asserts that the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Also, the examiner asserts that the preambles of instant claims 1-19 are not accorded any patentable weight, since the preamble does not breath life and meaning into the claims. "A preamble is not accorded any patentable weight where it merely



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recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976). See MPEP 2111.03.

Applicant further argues that Massaux does not teach or suggest in general that the abrasive agent comprises at least about 20% organic material. However, the examiner asserts that Massaux et al discloses with sufficient specificity that the abrasive material is selected from the group consisting of amorphous hydrated silica (i.e. a mineral particle), polyethylene powder particles, and mixtures thereof (col. 8, line 66-col. 9, line 3), which would include a 50-50 mixture of hydrated silica and polyethylene powder particles, per the requirements of the instant invention.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Mruk whose telephone number is (703) 305-0728. The examiner can normally be reached on Monday-Thursday from 7:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta, can be reached on (703) 308-4708. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9310 (Before Final) and (703) 872-9311 (After Final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

BPM

Brian Mruk  
April 11, 2003

*Lorna M. Douyon*

LORNA M. DOUYON  
PRIMARY EXAMINER